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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,072	05/10/2005	Andreas Van Eikeren	H01.2-11733-US01	8652
499 7590 11/10/2009 VIDAS, ARRETT & STEINKRAUS, P.A. SUITE 400, 6640 SHADY OAK ROAD EDEN PRAIRIE, MN 55344				
EXAMINER				
LEWIS, RALPH A				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
11/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,072

Applicant(s)

EIKEREN ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3, 5-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Acknowledgement of Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2009 has been entered.

Rejections based on Prior Art

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (US 6,305,936) in view of Futami et al, (US 4,778,832) Hare (US 5,661,222), Kamohara et al (US 6,291,546), Zech et al (US 6,677,393), Amstutz et al (US 4,559,013) and Kostner et al (US 4,204,324).

Jensen et al teach the application of a flowable material 28 to the gums of a patient which quickly cross links and isolates the teeth 14 which are to be treated from the gum tissue which is protected behind the applied composition. Jensen et al disclose

that the barrier material 28 is a methacrylate composition mixed immediately prior to or during use and applied with a syringe 30 before it cures. While Jensen et al disclose methacrylates, rather than the claimed addition and condensation silicones, Jensen et al do make it clear that other materials having similar properties may be used to accomplish the method (note particularly column 7, lines 9-12).

A-silicones and C-silicones that are mixed in a liquid state prior and then cured by cross linking are well known and commonly used in the dental arts as impression materials for the teeth and gums as evidenced, for example by, Futami et al, Hare, Kamohara et al and Zech et al. It is further known in the art to use such easily shaped silicones to create a thin layer shield over selective teeth and gums as taught by Amstutz et al (column 5, lines 8-15) and Kostner et al (column 3, lines 3-16). To have merely substituted common dental A-silicones and C-silicones which are known in the art to make beneficial shields which cover a patient's teeth and/or gums as taught by Amstutz et al and Kostner et al for the methacrylate compositions disclosed by Jensen et al would have been obvious to one of ordinary skill in the art, particularly in view of the Jensen et al disclosure that other compositions are capable of performing the disclosed method.

In response to the present rejection applicant argues that substituting A-silicones and C-silicones for the Jensen et al methacrylate compositions would not have been obvious to one of ordinary skill in the art because methacrylate compositions are hydrophilic while in contrast A-silicones and C-silicones are hydrophobic. Applicant argues that the prior art A-silicones and C-silicones compositions therefore do not have

similar properties to the Jensen et al methacrylate compositions and there substitution would not have been obvious. The examiner disagrees, Jensen et al appear to place no emphasis on the hydrophilic/hydrophobic nature of the masking material. Jensen et al teach applying a flowable composition to a patient's gums which rapidly cures in order to protect those gums from substances (e.g. bleaching agents) used on the teeth. The ordinarily skilled artisan would have readily recognized that the prior art A-silicone and C-silicone compositions, as pointed out in the rejection above, meet the properties of the composition required by Jensen et al.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
November 9, 2009

/Ralph A. Lewis/
Primary Examiner, Art Unit 3732